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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,130	01/09/2001	Benjamin Englander	2200600.131-US1	6441
28089	7590	11/07/2008		
WILMERHALE/NEW YORK 399 PARK AVENUE NEW YORK, NY 10022			EXAMINER NGUYEN, THONG Q	
			ART UNIT 2872	PAPER NUMBER
			NOTIFICATION DATE 11/07/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com

teresa.carvalho@wilmerhale.com

sharon.matthews@wilmerhale.com

Office Action Summary

Application No.

09/757,130

Applicant(s)

ENGLANDER, BENJAMIN

Examiner

Thong Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008 and 11 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendments filed on 4/10/08 and 7/11/08.
2. It is noted that in the amendment of 4/10/08, applicant has made changes to the specification and the claims. Regarding to the specification, applicant has filed a substitute specification with its marked-up copy and a statement that the substitute specification does not contain any new matter. Regarding to the claims, applicant has amended claims 1 and 9 and added a new set of claims, i.e., claims 10-15, into the application. There is not any claim being canceled from the application.
3. In the amendment of 7/11/08, applicant has amended claims 1, 9 and 10. There is not any claimed being added or canceled from the amendment of 7/11/08. It is noted that applicant has submitted a set of letters to support for the statement related to the commercial success of the invention. It is also noted that applicant submitted excerpts from the state of Florida's 2006 school bus specification which discloses the requirements of a mirror installed in a school bus.
4. A review of the pending claims has resulted that the device as claimed in the newly-added claims 10-15 has a similar scope as that of the amended claims. Thus, all pending claims 1-7 and 9-15 are examined in this Office action. Note that claim 8 was canceled in the amendment of 8/21/2007.

Specification

5. The substitute specification with its marked-up copy and a statement that the substitute specification does not contain any new matter filed by applicant on 4/10/08 has been approved and entered.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The rejection of claims 1-7 and 9 under 35 U.S.C. 112, first paragraph, as set forth in the previous Office action of 10/11/07, pages 4-6, have been overcome by the amendments to the claims as provided in the amendment of 7/11/2008.

8. Claims 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Claim 10 is rejected under 35 USC 112, first paragraph because of the following reasons:

First, the disclosure, as originally filed, does not provide support for the feature related to the connection of the mirror mount and the so-called "a front location of a school bus or vehicle" as recited on lines 4-5 of the claim;

Second, the disclosure, as originally filed, does not provide support for the feature thereof "an antiglare...second image portion" as recited in the claim, lines 12-20. In particular, the disclosure, as originally filed, does not provide support for the feature that the treated upper area of the dome shape mirror surface above the bottom half of the contoured outer mirror surface "reduce glare from sun rays emanating at least from a direction in front of the driver from the front or sides of the school bus or vehicle with respect to a first image portion located above the bottom half portion of the mirror element while darkening the first image portion reflected thereby, and wherein the bottom half portion of the mirror element is free of antiglare material that reflected a second image portion without darkening the second image portion". It is noted that the disclosure, as originally filed, does not disclose any support related to the so-called "first image portion", "the second image portion" and their structural relationships with the front or side of the school bus or vehicle.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 10 is rejected under 35 USC 112, second paragraph for the following reason:

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "the contour outer mirror surface facing toward the vehicle (the school bus or vehicle ?) to which the mirror element is mounted" (claim 10, lines 9-10), and the claim also recites "the contoured outer mirror surface of the mirror element facing toward a driver of the school bus or vehicle" (claim 10, lines 10-11) which is the narrower statement of the range/limitation.

b) Each of claims 11-13 and 15 is rejected under 35 USC 112, second paragraph because the feature thereof "the three-dimensional upper area" recited in claim 11 (lines 1-2), claim 12 (lines 1-2), claim 13 (line 2) and claim 15 (lines 2-3) lacks a proper antecedent basis. Applicant should note that the amended claim 10 has canceled the

antecedent basis for the feature "three-dimensional" recited in each of claims 11-13.

c) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-6 and 9-15, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout (U.S. Patent No. 4,822,157, of record) in view of Falge (U.S. Patent No. 1,768,354, of record).

Stout discloses a school bus with a mirror assembly installed to a front fender of the bus for the purpose of providing the driver of the bus visual access to the area in front of the school bus as well as to the sides of the bus. See abstract and column 2 (lines 29-34). The mirror assembly as stated at column 2 and shown in figures 1-3 comprises a mirror element (26) having an oval ellipsoidal shape and configured as a convex, generally dome shaped and contiguous mirror surface with its contoured outer surface facing in a direction of the driver. The mirror surface of the mirror element inherently has a size wherein the entirety of the mirror surface is utilized to provide a single, integrated wide angle filed of view of a scene which includes the front and at least one side of the bus wherein their images are viewed by the driver of the bus via the reflections from the mirror surface. The mirror assembly is secured to a mirror pole (20) via a securing means (48, 50, 52). The mirror pole (20) in turn is inherently secured to

the front fender of the school bus. See column 3 and fig. 1. As such, the mirror assembly provides and maintains the scene which includes the front and at least one side of the bus wherein their images are viewed by the driver of the bus via the reflections from the mirror surface while the drive drives the bus. As a result of such structure, the school bus with the mirror assembly attached therein as provided by Stout meets all of the limitations of the device as claimed except a portion of the mirror element being treated for reducing glare.

The treatment on a portion of the mirror element, in particular, on an upper portion of the mirror, for the purpose of reducing glare is known to one skilled in the art as can be seen in the optical system provided by Falge. In particular, Falge discloses a mirror system having a mirror surface wherein the upper portion of the mirror is treated to reduce glare without rendering the treated portion opaque as to be non-reflective. See Falge, pages 1-2 and figs 1 and 8, for example. Regarding to the material used to treat the upper portion of the mirror, Falge discloses that one of the material used comprises black enamel, see column 3, lines 6-14, or translucent material such as celluloid or pyralin, colored green or other materials which effect a reduction in the intensity of light incident thereon, see column 4, lines 1-14. Regarding to the dimension/size of the portion being treated (36) for reducing glare, in the embodiment of figure 8, the treated portion has an area of one-half of the upper one-third of the mirror (see page 2, column 4, lines 93-101). See also **In re Wertheim**, 541 F. 2d 257, 191 USPQ 90 (CCPA 1976), "the disclosure in the prior art of any value within a

claimed range is an anticipation of that range.” See also, **Titanium Metals Corporation of America**, 227 USPQ 773 (Fed. Cir. 1985), **In re Petering**, 301 F. 2d 676, 133 USPQ 275 (CCPA 1962). It is noted that the treated portion is located in spaced relation to and not in contact with any portion of the uppermost peripheral edge of the mirror surface along the vertical direction of the mirror surface.

Regarding to the feature that the treated portion is located in the area defined from an uppermost position on the contoured mirror surface and a straight notional line which bisects the mirror surface in the horizontal direction, such a feature is readable from the mirror having treated portion provided by Falge. In other words, in each embodiments shown in fig. 1 and fig. 8, the treated portion is located in a notional straight line which bisects the mirror surface in a horizontal direction. Applicant should note that notional straight line which bisects the mirror surface in a horizontal direction is merely that of an imaginary line, not a physical line or resulted from a mechanical construction/structure of the mirror surface.

With regard to the feature concerning the formation of the coating band as recited in claim 4, such a feature is directed to a method step and thus is not given a patentable weight. See **In re Dike**, 157 USPQ 581 (CCPA 1968).

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the mirror assembly provided by Stout by making a portion of the upper one-third of the mirror as a treated portion as suggested by

Falge for the purpose of providing a mirror assembly with a portion of its upper section having the function of reducing glare. It is also noted that the combined product as provided by Stout and Falge inherently will provide a reduction in glare caused by sun light during the operation of the school bus because the combined product is installed in a school bus which is operated in daytime for transportation students to school and back to their homes.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stout in view of Falge as applied to claim 1 above with or without Malifaud (U.S. Patent No. 3,199,114, of record).

The combined product as provided by Stout and Falge as described above meets all of the features recited in present claim 7 except the treated portion is located on one side relative to the minor axis of the mirror surface. However, such an arrangement of a treated portion with respect to the area of an optical element having a substantially oval shape as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for this conclusion is found in the present specification in which applicant has taught that the treated portion is extended on both side of the minor surface as can be seen in the embodiment described at pages 4-5 and illustrated in present figure 2A-2C. Furthermore, the use of an anti-glare portion which is located on one side of an optical element having an oval shape and on a side relative to a minor axis of the optical element is known to one skilled in the art as can be seen in the anti-glare system provided by Malifaud. See column 5 and fig. 5. Thus, absent any

showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to utilize the teaching, i.e., use the antiglare portion on just one side of an optical element as suggested by Malifaud in the combined product provided by Stout and Falge by using a portion on just one side of the minor axis of a mirror surface which portion is necessary to the driver's field of view as a treated portion for reducing glare and simultaneously reducing the manufacture cost.

Response to Arguments

14. Applicant's arguments filed on 4/10/08, pages 13-16, have been fully considered but they are not persuasive for the following reasons.

First, regarding to the applicant's arguments that the combined art does not disclose the feature related to a portion of the outer surface of the mirror is treated to reduce glare, see amendment, page 14, the examiner respectfully disagrees because such a feature as recited in the claims would have been obvious to one skilled in the art by the teachings provided by the prior art. In particular, *Falge discloses a mirror system having a mirror surface wherein the upper portion of the mirror is treated to reduce glare without rendering the treated portion opaque as to be non-reflective. See Falge, pages 1-2 and figs 1 and 8, for example.* Regarding to the material used to treat the upper portion of the mirror, Falge discloses that one of the material used comprises black enamel, see column 3, lines 6-14, or translucent material such as celluloid or pyralin,

colored green or other materials which effect a reduction in the intensity of light incident thereon, see column 4, lines 1-14.

Applicant is respectfully invited to review the rejections of the claims as provided in this Office action. *In the light of such a teaching, one skilled in the art will utilize the teaching as provided by Falge by treating an upper portion of a mirror whether the portion being treated of the mirror is on an outer surface or a back surface of the mirror for the purpose of obtaining a product with better optical performance.* Applicant should further note that it was decided in the Courts that a rearranging parts of an invention involves only routine skill in the art, see *In re Japikse*, 86 USPQ 70, and a mere reversal of the essential working parts of a device involves only routine skill in the art, See *In re Einstein*, 8 USPQ 167; *In re Gazda*, 104 USPQ 400.

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Third, In response to applicant's argument that the mirror provided by Stout, the primary reference, is a cross view mirror while the mirror provided by Falge, the secondary reference, is a rearview mirror mounting inside a vehicle, see amendment of 4/10/08, pages 14-15, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure

of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Fourth, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both devices provided by Stout and Falge are directed to mirrors for use by a vehicle's driver for viewing the scenes around the vehicle. Since it is a common knowledge that any mirror is subjected to a glare problem which causes a problem for a driver while (s)he operates the vehicle, thus it is within the level of one skill in the art to reduce or eliminate the glare problem to avoid the accident and the disadvantages occurred to a vehicle's driver. Stout discloses a mirror for use with a school bus, and Falge discloses an apparatus for treating the mirror to reduce glare, thus, it would have been obvious to one skill in the art to modify the mirror provided by Stout, the primary reference, by utilizing the teachings provided by Falge, the secondary reference,

for the purpose of showing that the treatment on a portion of the mirror element, in particular, on an upper portion of the mirror, for the purpose of reducing glare. Fifth, regarding to the rejections of dependent claims 2-7, since applicant has not provided any specific arguments, see amendment of 4/10/08, pages 15-16, thus the rejections of such claims are repeated with the same reasons as set forth in the previous Office action.

15. The submissions of letters to support for the statement related to the commercial success of the invention under 37 CFR 1.132 filed on 7/11/08 are insufficient to overcome the rejection of claims 1-7 and 9, now applied to claims 1-7 and 9-15 based upon the combined teachings provided by Stout (U.S. Patent No. 4,822,157) and Falge (U.S. Patent No. 1,768,354) as set forth in the last Office action. Applicant's arguments as provided in the amendment of 7/11/08, pages 8-12, have been fully considered but they are not persuasive for the following reasons. The letters have stated that the company, Rosco, Inc. has sold ten of thousands of the mirrors with the antiglare tint. A bare statement in each of the letter without any written data for supporting the numbers of mirror being sold is not sufficient to overcome the rejection. In particular, it is unclear about the time in which the numbers of mirror being sold as stated in the letter. In other words, it is unclear whether the numbers of mirror sold as stated in the letter is for a period of ten years, or fifteen years, It is noted that the letters do not provide the data showing the sale figures of competing products of the company Rosco, Inc and other companies making a similar product. The letters also do not show the number related to

the dollar market share, the expensive price is for the merit of the present invention or it is the result of other factors, ...

16. Regarding to the submission of excerpts from the state of Florida's 2006 school bus specification which discloses the requirements of a mirror installed in a school bus, such a submission is insufficient to overcome the rejection. Applicant should note that the excerpts are just listed some requirements for a mirror installing on a school bus based on the Florida requirements, they do not provide any meaning or any support for the invention as claimed.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/

Primary Examiner, Art Unit 2872